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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,832	01/12/2004	Viktors Berstis	AUS920030667US1	9835
45993 7590 09/05/2007 IBM CORPORATION (RHF) C/O ROBERT H. FRANTZ P. O. BOX 23324 OKLAHOMA CITY, OK 73123			EXAMINER NGUYEN, PHILLIP H	
			ART UNIT 2191	PAPER NUMBER
			MAIL DATE 09/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/755,832

Applicant(s)

BERSTIS ET AL.

Examiner

Phillip H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the amendment filed on 6/6/2007.
2. Claims 1, 5, 9, 10 and 12 have been amended.
3. Claims 1-14 remain pending and have been considered below.

Information Disclosure Statement

4. The information disclosure statement filed 6/6/2007 fails to comply with the provisions of 37 CFR 1.98 (b) and MPEP § 609 because it does not meet the requirement for the following reason "Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication." It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Response to Arguments

5. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Specification

6. The amendment filed 6/6/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Claims 1, 5 and 9 recite "user enablement of automatic natural language translation" and "electronic document". There is not written description or support in the specification about "electronic document." Examiner interprets them as "natural language translation" and "document."

If Applicant believes that these are not new matters, he must show where in the specification that these newly added limitations are described. Otherwise, applicant is required to cancel the new matter in the reply to this Office Action.

Double Patenting

7. The amendment filed on 6/6/2007 does not overcome the potential double patenting rejection to claims 1, 5 and 9 of previous action. Therefore, Examiner maintains the rejection.

Applicant asserts on page 10-13 of the amendment that Examiner fails to compare the differences between the copending application and the instant application. Applicant further shows a comparison table between the two applications to clarify the differences.

Examiner respectfully disagrees with all the allegations as argued. As we can see from the comparison table given by applicant, the claim in the co-pending application (10/865,347) has more details comparing to the instant application. In other words, the co-pending application contains all the limitations of the instant application plus additional limitations. The instant application is claiming the limitations that have been already claimed in the co-pending application.

The instant application is broader and the co-pending application is narrower. Therefore, the double patenting rejection was given.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 5 and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 12 and 22 of copending Application No. 10/865,347. Although the conflicting claims are not identical, they are not patentably distinct from each other because limitations in one claim can obviously be applicable in the corresponding claim.

Examiner reconstructs a similar table given by Applicant as an example to demonstrate the reason for the rejection.

Instant Application	Co-pending Application	Comparison Notes
1. A method for transferring <u>content</u> from one computer resource to another computer resource, comprising the steps of:	12. A method for transferring computer-readable <u>image content</u> from one computer resource to another computer resource, comprising the steps of:	Content includes: image content, text data audio, etc.
intercepting the transfer of one or more information elements selected from a source to a destination;	intercepting the transfer of a source image element from a computer-readable source to a computer-readable destination;	Similar steps in both claims.

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	recognizing one or more embedded text instances within each said intercepted source image element;	Not present in the instant application.
determining if each intercepted information element is expressed in a natural language which matches a user-specified natural language;	determining if each embedded text instance is expressed in a natural language which matches a user-specified destination natural language;	The same steps in both applications.
performing one or more natural language handling actions on information elements which do not match said user specified natural language as defined by one or more natural language handling rules;	performing natural language translation of one or more embedded text instances which do not match said user specified destination natural language;	Similar steps in both claims.
	rendering translated text data for each translated text instance;	Not present in the instant application.
	producing a modified	Not present in the instant

	computer-readable image element by replacing each embedded text instance with a corresponding translated embedded text image; and	application.
transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions.	transferring said modified image element to said computer readable destination.	Similar step in both claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

10. The amendment filed on 6/6/2007 overcomes the rejection set forth to claims 1 and 5 of previous action. Therefore, the rejection is withdrawn.

11. Claims 1, 5 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 5 and 9 recite "user enablement of automatic natural language translation" and "electronic document". There is not written description or support in the specification about "electronic document." Examiner interprets them as "natural language translation" and "document." Furthermore, examiner does not understand the phrase "with a user enablement of automatic natural language translation."

If Applicant believes that these are not new matters, he must show where in the specification that these newly added limitations are described. Otherwise, applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 101

12. The amendment filed on 6/6/2007 does not overcome the 101 rejection for claims 9-14 of previous action. Therefore, examiner maintains the rejection.

Application asserts on page 15 of the amendment that the system described in the specification (paragraph 0044-0064) includes software and hardware.

Examiner respectfully disagrees with all the allegations as argued. Examiner agrees with the applicant that the system described in the specification comprises at least some hardware components. However, the claimed system in claims 9-14 does not contains any hardware components such as CPU, ROM, RAM, etc. to carry out the recited steps. Therefore, examiner maintains the rejection to claims 9-14 for claiming software.

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- Regarding claim 9-14, recite a cut-and-paste system but it appears reasonable to interpret this system by one of ordinary skill in the art as software, per se.

Applicant's specification provides no explicit and deliberate definition of the components ("information transfer interceptor", "natural language comparator", "natural language handler", and "information element deliver") that make up the system other than they could be software components, which are directed to functional descriptive material, per se, and are therefore non-statutory.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. "Synchronized Clipboards of Multiple Computers."

As per claims 1, 5 and 9:

Miller discloses:

- receiving a user command to enable automatic cutting-and-pasting in a destination first, source second sequence, with user enablement of automatic natural language translation (see at least page 1, col. 1, 3rd paragraph "**copy-and-paste**") ;

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- subsequent to receiving said command and enablement, receiving a user selection of one or more insertion points in the contents of a destination computer resource via a destination user interface, said computer resource consisting of an electronic document (see at least page 1, col. 1, 3rd paragraph ***"select an item on one computer, copy it to the clipboard (using the standard copy command available in most application), the turn to the other computer and paste the item"***);
- subsequent to receiving said user-selected insertion point, receiving a user selection of one or more information elements via a source user interface (see at least page 1, col. 1, 3rd paragraph ***"select an item on one computer, copy it to the clipboard (using the standard copy command available in most application), the turn to the other computer and paste the item"***); and
- intercepting transfer of said information elements to a destination (see at least page 1, col. 2, 5th paragraph ***"intercepts clipboards-related system traps on the PalmPilot and redirects them to the PC clipboards"***).

Miller does not explicitly disclose:

- determining which intercepted information elements are expressed in a natural language not matching a user-specified natural language;
- performing one or more natural language handling actions on information elements which do not match said user specified natural language as defined by one or more natural language handling rules; and

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- transferring any information elements to said destination which have been translated to said user specified natural language as a result of said handling actions.

However, Uribe-Echebarria Diaz De Mendibil teaches natural languages translation.

Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to recognize that natural languages translation is well known in the relevant art and incorporate Uribe-Echebarria Diaz De Mendibil's approach with Miller's approach. The modification is obvious because instead of performing two steps cut-and-paste the contents into a document and translate, a user can translate the contents while cut-and-paste in one step. This short cut saves time.

As per claims 2, 6 and 10:

Uribe-Echebarria Diaz De Mendibil further discloses:

- wherein said handling actions comprise isolating certain information elements according to said handling rules, thereby blocking their transfer to said destination (see at least the abstract "***extracting the structural analysis of the sentences in the target language***").

As per claims 3, 7 and 11:

Uribe-Echebarria Diaz De Mendibil further discloses:

- wherein said handling actions comprise determining an original natural language in which each intercepted information elements is expressed (see at least the

abstract "***analysis of the sentences of a source-language text in order to impart to them the corresponding morphological, syntactical and semantic characteristics***"), and subsequently invoking a computer translation process to translate each item from said original natural language to said user-specified natural language (see at least the abstract "***converting the sentences of the target language in a interlingua into sentences in a target language with its specific vocabulary and in order to conclude the translation***").

As per claims 4, 8 and 12:

Uribe-Echebarria Diaz De Mendibil does not explicitly disclose:

- invoking a rule management user interface responsive to finding no existing natural language handling rule for an information element to be transferred; and allowing, via said rule management user interface, a user to define an action to be taken selected from the list of invoking a natural language translation process, allowing transfer without modification, and isolating said information element.

However, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to recognize that if there is no existing natural language for an information element to be transferred, no translation is performed. One would have been motivated not to perform a translation since no existing natural language for an information element is found.

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As per claim 13:

Uribe-Echebarria Diaz De Mendibil does not explicitly disclose:

- wherein said rule management user interface is manually invoked by said user.

However, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to recognize that invoking an user interface is well known in the relevant art either by user or automatically by an application. One would have been motivated to allow user to manually invoking an interface because it allows user to have a control over the operation.

As per claim 14:

Uribe-Echebarria Diaz De Mendibil does not explicitly disclose:

- wherein said rule management user interface is automatically invoked responsive to finding no existing natural language handling rule for an intercepted information element.

However, it would have been motivated to one having an ordinary skill in the art at the time the invention was made to recognize that automatically invoking an user interface is well known in the art. One would have been motivated to allow the automatically invoke an user interface to minimize the manually operation.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Thursday 10:00 AM - 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PN
8/8/2007



WEI ZHEN
SUPERVISORY PATENT EXAMINER